

REMARKS

This Amendment and Response is filed in response to the Office Action dated December 30, 2002. Initially, Applicants' attorney wishes to thank Examiner Harris for the careful consideration given this application. However, Applicant respectfully submits that U.S. Patent No. 6,302,698 to Ziv-El (the "'698 Patent"), cited in support of each of the rejections under 35 U.S.C. §103(a), is not properly considered prior art pursuant to 35 USC§ 103(c). 35 USC§ 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As discussed more fully below, the '698 Patent qualifies as prior art only under 35 USC§ 102(e) and has been commonly owned with the present application at all relevant times. Accordingly, pursuant to 35 USC§ 103(c), it cannot be considered as the basis for a rejection under 35 USC§ 103(a).

As mentioned, this application and the '698 Patent were, at the time the invention of this application was made, and at all times thereafter commonly owned. On March 26, 1999, the sole inventor for U.S. Serial No. 09/250,687 (the "'687 Application"), Jacob Ziv-El, assigned all right, title and interest in the application and any patents issuing therefrom to Discourse Technologies, Inc. On October 16, 2001, the '687 application issued as the '698 Patent. A copy of the assignment agreement together with the associated recordation sheet is attached hereto as Exhibit A.

Similarly, on January 10, 2001, each of the inventors of the present application assigned all right, title and interest in this application and any patents which would issue therefrom to Discourse Technologies, Inc. A copy of that assignment agreement is attached hereto as Exhibit B.

In addition, on August 22, 2002, both this application and the '698 Patent were subsequently assigned from Discourse Technologies to Educational Testing Service, the current Assignee. A copy of that assignment agreement is attached hereto as Exhibit C. Accordingly,

the '698 Patent and the present application both at the time the present application was filed and at all times thereafter were commonly owned.

Turning to the particular rejections, claims 1-13, 14-17, 20-22, 25-35 and 37 stand rejected by the Examiner under 35 USC§ 103(a) as being unpatentable over Ziv-El (U.S. Patent 6,302,698) in view of Helmick, et. al., (U.S. Patent 6,470,171). The '698 Patent was filed February 16, 1999 but did not issue until October 16, 2001. However, the present application was filed January 12, 2001 approximately nine (9) months prior to the issuance of the '698 Patent. Therefore, the '698 Patent would only qualify as prior art for purposes of this application under 35 USC§ 102(e). As stated above, under 35 USC§ 103(c), prior art under 35 USC§ 102(e), (f) or (g) which is commonly owned with the present application may not be considered for purposes of applying 35 USC§ 103(a). Accordingly, it is respectfully submitted that pursuant to 35 USC§ 103(c) the '698 Patent is not proper prior art under 35 USC§ 103(a) and the rejection should be withdrawn.

Claims 18-19 and 23-24 stand rejected under 35 USC§ 103(a) being unpatentable over Ziv-El. For the reasons set forth above, it is submitted that, pursuant to 35 USC§ 103(c), the '698 Patent is not proper prior art under 35 USC§ 103(a) and can not form the basis of a rejection under 35 USC§ 103(a). Accordingly, it is respectfully requested that the rejection be withdrawn.

Finally, the claims have been slightly amended for clarification purposes.

In light of the foregoing, it is respectfully submitted that the '698 Patent is not proper prior art for purposes of 35 USC§ 103(a) and that the claims are in condition for allowance and notice of such effect is requested.. As a result, it is respectfully submitted that each of the rejections should be withdrawn.

Respectfully submitted,

PEPPER HAMILTON LLP



Raymond A. Miller
USPTO Registration No. 42,891

APR 30 2003

4:05PM

PEPPER HAMILTON LLP

NO. 155

P. 17

EXHIBIT

04-22-1999

Form PTO-1695
(Rev. 6-93)

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OMB No. 0851-0011 (exp. 4/94)



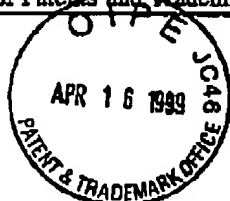
101015361

FEET

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Jakob Ziv-El
17-1 Ibn Gvirol Street
Herzliya Israel

2. Name and address of receiving party(ies):

Name: Discourse Technologies, Inc.

Internal Address: _____

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Street Address: 10218 North Port Washington
RoadCity: Maquon State: WI Zip: 53092Additional name(s) & address(es) attached? ☐ Yes ☒ NoExecution Date: March 26, 1999

4. Application number(s) or patent number(s):

If this document is being filed with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

09/250,687

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Michael J. McGovernInternal Address: Quarles & Brady LLPStreet Address: 411 East Wisconsin AvenueCity: Milwaukee State: WI Zip: 532026. Total number of applications and patents involved: ☐7. Total Fee (37 CFR 34) \$40.00☐ Enclosed☒ Authorized to be charged to deposit account

8. Deposit account number

17-0055

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

04/20/1999 SARAYA 00000022 170055 09250687

01 FC:581 40.00 CH

9. Statement and signature

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*Michael J. McGovern
Name of person signingApril 13, 1999
DateTotal number of pages including cover sheet, attachments and document: 2

ASSIGNMENT

WHEREAS, I, Jakob Ziv-El of Herzliya, Israel have made certain inventions which are described in an application for Letters Patent of the United States No. 09/250,687, filed February 16, 1999 and entitled METHODS AND APPARATUS FOR ON-LINE TEACHING AND LEARNING, and

WHEREAS, Discourse Technologies, Inc. (hereinafter referred to as said Company), a Wisconsin corporation having a place of business at 10218 North Port Washington Road in Mequon, Wisconsin 53092 is desirous of acquiring the entire interest in said inventions throughout the United States of America and the territories thereof, for all other countries and under all international agreements,

NOW, THEREFORE, for and in consideration of One Dollar (\$1.00) to me in hand paid, and other good and valuable consideration, receipt whereof is hereby acknowledged, I hereby sell, assign and transfer unto said Company, its successors and assigns, the entire right, title and interest throughout the United States of America and the territories thereof, for all foreign countries and under all international agreements in and to said inventions, the aforesaid application, all other applications hereafter filed in the United States, in any other country, or under any international agreement based in whole or in part on said inventions, and all Letters Patents granted upon said applications by the United States, by any other country or under any international agreement, and I do hereby authorize and request the Commissioner of Patents and Trademarks to issue said Letters Patent to said Company. I further grant to said Company, its successors and assigns, the right to claim for any of said applications the full benefits and priority rights of any international agreement between the United States and any foreign country or countries or between any other countries.

I hereby warrant that I have the full right to make the conveyance herein, and I hereby covenant that I, my heirs, legal representatives and assigns, will when requested, communicate to said Company, its representatives, successors and assigns, all facts known respecting said inventions, execute all divisional, continuing, reissue, reexamination and foreign or international applications, together with individual assignments therefor, make all rightful oaths, sign all lawful papers, testify in any legal proceeding and generally do everything possible to aid said Company, its successors and assigns, in the obtaining of Letters Patent.

IN TESTIMONY WHEREOF, I have hereunto set my hand and seal at the location and on the date indicated with my signature.

Date: March 26, 1999



Jakob Ziv-El

WITNESS #1:**WITNESS #2:**

Name: Evelyn Wolman

Name: Albert Wolman

Address: Evelyn Wolman

Address: Albert Wolman

March 26, 1999

March 26, 1999

17, Ibn Zvi Road

17, Ibn Zvi Road

Herzliya, Israel

Herzliya, Israel

ASSIGNMENT

WHEREAS, We, Shimon G. Ziv-el of Milwaukee, Wisconsin, Robert Tolly of Madison, Wisconsin, and Michael Dunk of Madison, Wisconsin have made certain inventions which are described in an application for Letters Patent of the United States entitled METHOD AND SYSTEM FOR ONLINE TEACHING USING WEB PAGES executed by us on even dates herewith preparatory to obtaining United States Letters Patent therefor, and

WHEREAS, Discourse Technologies, Inc. (hereinafter referred to as said Company), a Wisconsin corporation having a place of business at 10218 North Port Washington Road in Mequon, Wisconsin 53092 is desirous of acquiring the entire interest in said inventions throughout the United States of America and the territories thereof, for all other countries and under all international agreements,

NOW, THEREFORE, for and in consideration of One Dollar (\$1.00) to us in hand paid, and other good and valuable consideration, receipt whereof is hereby acknowledged, we hereby sell, assign and transfer unto said Company, its successors and assigns, the entire right, title and interest throughout the United States of America and the territories thereof, for all foreign countries and under all international agreements in and to said inventions, the aforesaid application, all other applications hereafter filed in the United States, in any other country, or under any international agreement based in whole or in part on said inventions, and all Letters Patents granted upon said applications by the United States, by any other country or under any international agreement, and we do hereby authorize and request the Commissioner of Patents and Trademarks to issue said Letters Patent to said Company. We further grant to said Company, its successors and assigns, the right to claim for any of said applications the full benefits and priority rights of any international agreement between the United States and any foreign country or countries or between any other countries.

We hereby warrant that we have the full right to make the conveyance herein, and we hereby covenant that we, our heirs, legal representatives and assigns, will when requested, communicate to said Company, its representatives, successors and assigns, all facts known respecting said inventions, execute all divisional, continuing, reissue, reexamination and foreign or international applications, together with individual assignments therefor, make all rightful oaths, sign all lawful papers, testify in any legal proceeding and generally do everything possible to aid said Company, its successors and assigns, in the obtaining of Letters Patent.

IN TESTIMONY WHEREOF, We have hereunto set my hand and seal at the location and on the date indicated with our signatures.

Date:

1/10/01


 Shimon G. Ziv-el

STATE OF WISCONSIN

)

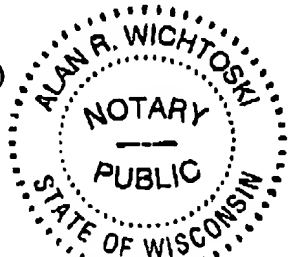

) SS

MILWAUKEE COUNTY

)

Before me on this 6th day of January, 2001, came Shimon G. Ziv-el to me known to be the person named in the foregoing assignment and acknowledged his execution thereof to be his free act and deed.

(SEAL)



 Notary Public,
 State of Wisconsin
 My Commission: 11/25/01

EXHIBIT

B

Date: 1/10/01Robert Tolly
Robert Tolly

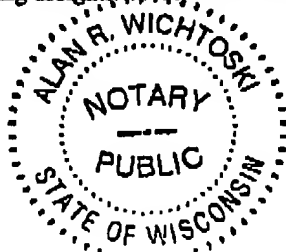
STATE OF WISCONSIN)

COUNTY)

) SS
)

Before me on this 10th day of January, 2001, came Robert Tolly to me known to be the person named in the foregoing assignment and acknowledged his execution thereof to be his free act and deed.

(SEAL)



Alan R. Wichtoski
Notary Public,
State of Wisconsin
My Commission: 11/25/01

Date: 1/10/01Michael Dunk
Michael Dunk

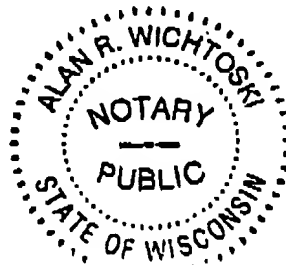
STATE OF WISCONSIN)

COUNTY)

) SS
)

Before me on this 10th day of January, 2001, came Michael Dunk to me known to be the person named in the foregoing assignment and acknowledged his execution thereof to be his free act and deed.

(SEAL)



Alan R. Wichtoski
Notary Public,
State of Wisconsin
My Commission: 11/25/01

Form PTO-1595
(Rev. 6-93)RECORDATION FORM COVER SHEET
PATENTS ONLYU.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

OMB No. 0851-0011 (exp. 4/94)

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Shimon G. Ziv-el
Robert Tolly
Michael DunkAdditional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: January 10, 2001

2. Name and address of receiving party(ies):

Name: Discourse Technologies, Inc.

Internal Address: _____

Street Address: 10218 North Port Washington
RoadCity: Mequon State: WI Zip: 53092Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed with a new application, the execution date of the application is: January 10, 2001

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

6. Name and address of party to whom correspondence concerning document should be mailed:

Name: Michael J. McGovernInternal Address: Quarles & Brady LLPStreet Address: 411 E. Wisconsin AvenueCity: Milwaukee State: WI Zip: 53202

6. Total number of applications and patents involved:

1

7. Total Fee (37 CFR 34) \$40.00

- ☐ Enclosed
☒ Authorized to be charged to deposit account

8. Deposit account number

17-0055

(Attach duplicate copy of this page if paying by deposit account)

9. Statement and signature

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a truecopy of the original document.*Michael J. McGovern
Name of person signing
Signature1/12/01
Date

Total number of pages including cover sheet, attachments and document: 3

#4679952
260198.90127Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents and Trademarks, Box Assignments
Washington, D.C. 20231

ASSIGNMENT OF PATENT APPLICATION

WHEREAS [Discourse Technologies, Inc.], a corporation of [Delaware] whose post office address is [1000 Lancaster St., MD 21202] (hereinafter referred to as Assignor) is the assignee of the entire right, title and interest in the invention entitled:

Method and System for On-Line Teaching Using Web Pages

For which an application for Patent was filed on January 12, 2001, Serial No. 09/760,267

WHEREAS, Educational Testing Service

a corporation of New York

whose post office address is 666 Rosedale Road, Mail Stop 38-D, Princeton, New Jersey 08541

(hereinafter referred to as Assignee), is desirous of securing the entire right, title, and interest in and to this invention in all countries throughout the world, and in and to the application for United States Letters Patent on this invention and the Letters Patent to be issued upon this application;

NOW THEREFORE, be it known that for good and valuable consideration, the receipt of which from assignee is hereby acknowledged, I as assignor, have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over unto the assignee, its lawful successors and assigns, my/our entire right, title, and interest in and to this invention, and this application, and all divisionals, and continuations thereof, and all Letters Patent of the United States which may be granted thereon, and all reissues thereof, and all rights to claim priority on the basis of the above provisional application (if any), as well as all rights to claim priority on the basis of this application, and all applications for Letters Patent which may hereafter be filed for this invention in any foreign country and all Letters Patent which may be granted on this invention in any foreign country, and all extensions, renewals, and reissues thereof; and I/We hereby authorize and request the Commissioner of Patents and Trademarks of the United States and any official of any foreign country whose duty it is to issue patents on applications as described above, to issue all Letters Patent for this invention to assignee, its successors and assigns, in accordance with the terms of this Assignment;

AND, I HEREBY covenant that I have the full right to convey the interest assigned by this Assignment, and I have not executed and will not execute any agreement in conflict with this Assignment;

AND, I HEREBY further covenant and agree that I will, without further consideration, communicate with assignee, its successors and assigns, any facts known to me/us respecting this invention, and testify in any legal proceeding, sign all lawful papers when called upon to do so, execute and deliver any and all papers that may be necessary or desirable to perfect the title to this invention in said assignee, its successors or assigns, execute all divisional, continuation, and reissue applications, make all rightful oaths and generally do everything possible to aid assignee, its successors and assigns, to obtain and enforce proper patent protection for this invention in the United States and any foreign country, it being understood that any expense incident to the execution of such papers shall be borne by the assignee, its successors and assigns.

IN TESTIMONY WHEREOF, I have hereunto set my hands.

Signature of Assignor:

Name of Assignor:

Address

[Signature] Date 8/27/02
Barry Offutt for Discourse Technologies, Inc.
1000 Lancaster St., Baltimore, MD 21202

EXHIBIT

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